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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,360	08/27/2001	Jeff M. Anderson	10018309-1	5091

7590 08/26/2004

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EXAMINER

VU, TUAN A

ART UNIT PAPER NUMBER

2124

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/940,360	Applicant(s) ANDERSON ET AL.	
	Examiner Tuan A Vu	Art Unit 2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/27/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed 8/27/2001.

Claims 1-20 have been submitted for examination.

Oath/Declaration

2. The declaration filed on 8/27/2001 has been put on record but contains the following informality.

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

The Applicant must disclose information material to patentability under 37 C.F.R. 1.56, not a portion of 37 C.F.R. 1.56 (e.g. 1.56(a) - see *U.S. Priority Claim* section of instant declaration). Applicant is asked to refer to 37 C.F.R. 1.63, which states the declaration must "state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56." A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Claim Objections

3. Claims 16 and 18 is objected to because of the following informalities: the element 'an operating system of the computer unable' (line 4, 3 of claims respectively) should be corrected to be 'the operating system of the computer' because without which the computer in the above part of the claim and said operating system would appear as grammatically and semantically disjoint entities. Appropriate correction is required.

Claim Rejections - 35 USC § 103

Art Unit: 2124

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fida International, "Prolink Hurricane 8000 ADSL Modem", *User's Manual*, VER. 1.5, 2000, pp. P1-P26 (hereinafter Fida) in view of Polycom, 'ViaVideo User's Guide', *ViaVideo QuickStart*, Nov. 2000, (hereinafter Polycom).

As per claim 1, Fida discloses a method for installing software on a computer for a device to be connected to the computer and performing one or more actions selected from the group of actions consisted of:

while installing the software, suppressing an automatic mode for the device initiated by an operating system of the computer upon the device being connected to the computer prior to the software being completely installed thereon (e.g. *CANCEL* – section 3.1.1 pg. P7); and

But Fida does not disclose instructing a user to connect the device to the computer after installing the software. The activation of a device being connected to the computer after installation of its pertaining software as disclosed by Fida suggests the motivation to ensure that the hardware device be connected in order for the installation to fully succeed and the device to get activated. Polycom, in a installation method of device being connected to a computer analogous to Fida wherein device driver or software components have to be installed first, discloses instructing the user to connect the device after the software has been installed (e.g. *Installing Hardware* - pg. 2). It would have been

Art Unit: 2124

obvious for one of ordinary skill in the art at the time the invention was made to provide to the installation process by Fida so that there is a provision requesting the user to connect the device after the step of installing the drivers is completed because the purpose is to prepare those drivers for the device to be properly installed/activated; and it is necessary that the user ensure that the device for which the driver is intended be connected for the installation to achieve such purpose.

Fida does not explicitly disclose that after installing the software on the computer, initiating the automatic installation mode for the device without having the computer rebooted. However, the concept of initiating the installation mode without having to reboot is evident when Fida applies the Plug and Play mode to initiate the installation mode because it is known in the art that Plug-and-Play enable installation of device being plugged on a running environment without having to restart the computer (section 3.1.2 P10 – Note: Plug&Play mode so that after copying the driver files and implicitly initiating a mode in the installation system, e.g. registry setting, so that the computer will be ready to activate and configure the installed Prolink device even before any restart takes place reads on initiating the installation mode without having to reboot). With the emphasis that initiating a mode is being interpreted as setting up a mode of installation through a Plug-and-Play process and that such mode when eventually executed would include configuring and activating the device, e.g. after a restart, the step of ‘initiating an installation mode without reboot’ is therefore disclosed by Fida.

As per claim 2, Fida discloses user manually initiating (e.g. steps 1, 2, 3 – section 3.1.2 P10

Art Unit: 2124

As per claim 3, Fida discloses inserting of a media (e.g. step 2, section 3.1.1 or step 2, sec 3.1.2)

As per claim 4, Fida discloses detecting a window, whether it is related to installation, related to automated mode, and closing the window (e.g. *CANCEL* – section 3.1.1 pg. P7)

As per claim 5, Fida discloses initiation of installation mode (re claim 1); and also re-enumeration routine of the computer system (e.g. P14, P16 Note: initiating the re-enumeration process via Plug-and-Play and enumeration data displayed to user thereafter as a result of the execution of such initiating step amounts to initiating installation mode by inherently calling re-enumeration routines).

As per claim 6, in view of the teachings by Polygon's using a GUI installation with interactive type buttons waiting for mouse-click events, this waiting for the user to confirm would have been obvious for the same grounds as set forth in claim 1.

As per claim 7, Fida discloses a computer medium with computer instructions to perform a method comprising: installing software for a device to be connected to a computer (e.g. section 3.1 p. P6) and while installing the software, detecting a window, whether it is related to installation, related to automated mode, and closing the window (e.g. *CANCEL* – section 3.1.1 pg. P7).

As per claims 8-10, the steps of associating variables or attribute to a button due to OS automatic detection of device within a window, such window having OS attributed handle, or some string identification imparted to such handle; and setting an countermanding action (a flag) upon the detection of such identification are all features inherent to Windows operating system and underlying process for identifying

Art Unit: 2124

components and their handles; therefore the detecting of window with CANCEL button as disclosed by Fida implicitly disclose the attribute, string resources, a flag identifying a automatic mode of claims 8-10.

As per claim 11, Fida discloses re-initiate the installation by detecting a CANCEL button (*CANCEL* – section 3.1.1 pg. P7) with its inherent window handle associating with a click on the CANCEL button; and also discloses a plug-and-play mode wherein automatic mode of installation keeps on proceeding (section 3.1.2), hence has disclosed appropriate action based on the window flag (plug-and-plug flag versus automatic mode flag) as addressed in claim 10.

As per claim 12, refer to claim 5.

As per claim 13, Fida discloses a point of sale device package comprising: a device to be connected to a computer via a connector of the device coupling to a corresponding connector of the computer (sec 2.1 – pg. P4) and means for suppressing an automatic mode for the device initiated by an operating system of the computer upon the device being connected to the computer prior to the software being completely installed thereon (e.g. *CANCEL* – section 3.1.1 pg. P7).

As per claim 14, Fida discloses a communication device (sec 2.1 – pg. P4 – Note: Modem being able to act as an signal processor for phone, PC, or a router is equivalent to a multi-function device); whereas Polygon discloses a camera (ViaVideo), both requiring USB port and installation of software first. It would have been obvious to combine the teachings of Fida and Polygon so that the device can also be a camera with the same benefits as taught from the rationale used in claim 1; because the more devices an invention can apply to the more marketable the product becomes.

Art Unit: 2124

As per claim 15, Fida discloses USB and IEEE-1394 (e.g. sec 2.1 – pg. P4 –

Note: Modem and IEEE-1394 were inter-compatible technologies at the time the invention was made).

6. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polycom, ‘ViaVideo User’s Guide’, *ViaVideo QuickStart*, Nov. 2000 in view of Vrhel, Jr et al., USPN: 6,543,047 (hereinafter Vrhel).

As per claim 16, Polygon discloses a computer-readable medium having computer instructions to perform a method comprising:

installing software on the computer for a device to be connected to the computer; instructing a user to connect the device to the computer (pg. 2-3);

waiting for the user to confirm such connection (e.g. *click the Install Hardware* - last para pg. 2 – Note: computer starts install upon user clicking reads on wait for confirmation); and initiating an automatic installation mode without rebooting or having a restart of the computer (e.g. *Installing Hardware, Starting ViaVideo* - pg. 2-3, the use of the camera after the hardware installing step reads on not having to restart the computer).

But Polygon does not disclose the computer operating system unable to automatically detect connection of the device to the computer. But Polygon intends on not detecting any device after the software has been installed. And the approach to make the operating system not detecting a device hot plug or demanding hardware driver based upon hardware detection, as if such detection is bypassed is taught by Vrhel. Vrhel, in a method to disable the automatic detection by the OS for driver installation by providing it with preinstalled default drivers (e.g. col. 11, lines 11-35). In view of the desirability to

Art Unit: 2124

bypass undesirable hardware detection prior to software being installed by Polygon, it would have been obvious for one of ordinary skill in the art at the time the invention was made to avert the automatic detection of the OS by providing some default drivers as suggested by Vrhel because this would lead the installation of the device under the control of the user by initiating the software installation step just as suggested by Polygon without requiring the user to not connect the hardware, and alleviate mismatch issues when driver/software files are being carefully selected by the user when the user is offered the charge of such installation.

As per claim 17, Polygon does not explicitly disclose in the step of initiating automatic installation mode the calling of hardware re-enumeration routine. But based on the settings of the computer and the ability to use the camera after the automatic mode has been achieved, this registration of files in the computer registry otherwise known as re-enumeration results are implicitly disclosed (e.g. pg. 2-3, Note: the use of the camera after the hardware installing step reads on registry containing re-enumeration results by OS of the computer)

As per claim 18, Polygon discloses a point of sale device package comprising device and computer coupling via corresponding connectors (e.g. Hardware / Software requirements pg. 1-2); means for installing software for the device (pg. 2); for initiating automatic installation mode after the software is installed, without rebooting (pg. 2-3, Note: the use of the camera after the hardware installing step reads on registry containing re-enumeration results by OS of the computer).

Art Unit: 2124

But Polygon does not disclose operating system unable to automatically detect connection of the device to the computer. But this step has been addressed in claim 16 above.

As per claims 19 and 20, Polygon discloses a camera (e.g. ViaVideo pg. 3); and a parallel or serial port (Hardware / Software requirements pg. 1-2 , e.g. standard PC port).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (703)305-7207. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

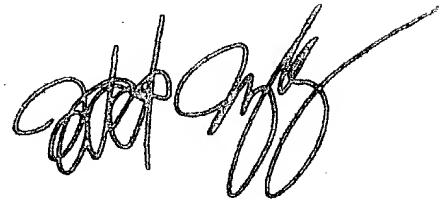
Washington, D.C. 20231

or faxed to:

(703) 872-9306 (for formal communications intended for entry)

or: (703) 746-8734 (for informal or draft communications, please consult Examiner before using this number)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA. , 22202. 4th Floor(Receptionist).



**TODD INGBERG
PRIMARY EXAMINER**

Art Unit: 2124

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAT

August 19, 2004